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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,745	01/17/2001	John Purcell	053136-5001	4823

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EXAMINER


ALPERT, JAMES M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No.	Applicant(s)	
	09/760,745	PURCELL, JOHN	
	Examiner	Art Unit	
	James Alpert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The application has been examined, and Claims 1-34 are pending. The objections and rejections are as stated below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22,28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magary et al., U.S. Patent Application Publication #20010056387, in view of Kitain et al., U.S. Patent #5864871. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magary et al., U.S. Patent Application Publication #20010056387, in view of Kitain et al., U.S. Patent #5864871, and further in view of Lerner et al., U.S. Patent Application Publication #20010034678.

With regard to Claim 1, Magary teaches the system comprising:

an E-broker system with a database that sends information to and receives information from an Investor through an investor system; (Figure 1, Item 110)

Magary does not teach the following limitation:

an electronic dissemination and tabulation system ("EDT") for delivering information to or receiving information from the investor system in response to an investor system request sent via the E-broker system;

However, Kitain does teach this limitation at (Col. 11, lines 43-67). Kitain generally teaches of a system and method for electronically delivering information and

other SEC related documents by an issuer to its shareholders. Magary teaches of distributing such documents through broker web sites. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described here in Claim 1. The motivation for such a combination is, as Kitain suggest at (Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors. Magary does teach the final limitation, wherein:

the EDT system sends information to the investor system in correspondence to stock holdings of the Investor as recorded in the E-broker system.
(Page 3, Para. 33)

With regard to Claim 2, Magary teaches the system wherein:

an electronic indication notifies the Investor that information is available or information is requested from either the EDT system or the E-broker system. (Page 4, Para. 46)

With regard to Claim 3, Magary teaches the system wherein:

wherein the communication between the EDT, E-broker, and investor systems use a layering model protocol including at least an application layer, a transport layer an Internet layer, a network interface layer and a physical layer. (Page 1, Paras. 17-18, describing use of URL's and the Internet, which follow the standard 7-layer protocol)

With regard to Claim 4, Magary teaches the system wherein:

the investor system request results from a click on an icon on a website of the E-broker system. (Page 2, Para. 23)

With regard to Claim 5, Magary teaches the system wherein the:

electronic dissemination and tabulation system provides information by hyperlinked text.
(Page 1, Para. 17)

With regard to Claim 6, Magary teaches the system wherein:

other E-broker systems in addition to the E-broker system inform the EDT system of what information can be sent to or received from the investor system by record keeping of online activities of Investors in each respective E-broker system.
(Page 3, Para. 33)

With regard to Claim 7, Magary does not teach the system wherein:

the electronic dissemination and tabulation system provides information that includes streaming video.

However, Kitain teaches this limitation at (Col. 5 lines 15-35). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to include streaming video as part of the dissemination and distribution. The motivation for such a combination is, as Kitain suggest, that there is a need for information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36). Items such as streaming video inure to the benefit of investors.

With regard to Claim 8, Magary teaches the system comprising:

an investor system for an Investor to send and receive information;
(Page 2, Para. 23)

an E-broker system, having a website, that sends information to and receives information from an investor system; (Page 2, Para. 23)

and wherein the website enables the electronic dissemination and tabulation system to send information to or receive information from the investor system in correspondence to stock holdings of the Investor as recorded in the E-broker system. (Page 3, Para. 33)

Magary does not teach the remaining limitations of this claim, however Kitain discloses them:

an electronic dissemination and tabulation system for delivery of information to or reception of information from the investor system; (Col. 11 lines 43-67)

online delivery of documents to Investors, and receiving voting or tendering instructions: (Col. 10 lines 26-45)

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described here in Claim 8. The motivation for such a combination is, as Kitain suggest at (Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors.

With regard to Claim 9, Magary teaches the system wherein:

the investor system is e-mailed notification that information is available on or information is requested by the electronic dissemination and tabulation system. (Page 4, Para. 44)

With regard to Claim 10, Magary teaches the system wherein:

the communication between the issuer, electronic dissemination and tabulation, E-broker, and investor systems uses a layering model protocol including at least an application layer, a transport layer an Internet layer, a network interface layer and a physical layer. (Page 1, Paras. 17-18, describing use of URL's and the Internet, which follow the standard 7-layer protocol)

With regard to Claim 11, Magary teaches the system wherein:

a single click in an area of the website by the Investor enables the electronic dissemination and tabulation system to send information to the investor system. (Page 2, Para. 23)

With regard to Claim 12, Magary teaches the system wherein:

the E-broker system provides information to the electronic dissemination and tabulation system of what information can be sent to or received from the investor system through record keeping of activities of the Investor on the E-broker system. (Page 1, Para. 18)

With regard to Claim 13, Magary teaches the system wherein:

other E-broker systems in addition to the E-broker system provide information to the electronic dissemination and tabulation system of what information can be sent to or received from the investor system by record keeping of online activities of all Investors on each respective E-broker system. (Page 3, Para. 33)

With regard to Claim 14, Magary teaches the method comprising:

requiring information from Investors of the Issuer who trade on-line with at least one E-broker system; (Page 2, Para. 28)

the Investors connecting to the electronic dissemination and tabulation system via a website of the at least one E-broker system for information from the Issuer.
(Page 4, Para. 47)

Magary does not expressly teach the following limitation:

an Issuer of investment securities, or an agent thereof, notifying an electronic dissemination and tabulation system of an event

However, in a similar case, Kitain teaches this limitation at (Col. 10, lines 5-15).

Kitain generally teaches of a system and method for electronically delivering information and other SEC related documents by an issuer to its shareholders. Magary teaches of distributing such documents through broker web sites. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 14. The motivation for such a combination is, as Kitain suggest, that there is a need for information delivery system that meets the needs of both corporations and of investors.
(Col. 4 lines 31-36)

With regard to Claim 15, Magary teaches the method wherein:

the Investor can only connect via a website of the at least one E-broker system to the electronic dissemination and tabulation system where the Investor bought investment securities of the Issuer through the at least one E-broker system. (Page 2, Para. 21)

With regard to Claim 16, Magary teaches the method wherein:

the electronic dissemination and tabulation system e-mails the Investor to inform the Investor of the event. (Page 4, Para. 44)

With regard to Claim 17, Magary does not teach the method wherein:

the electronic dissemination and tabulation provider searches more than one E-broker system to determine the Investors of the Issuer who trade investments on-line.

However, in a similar case, Kitain teaches this limitation at (Col. 10, lines 26-32). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary, related to the distribution of documents through broker web sites, with Kitain, related to searching for investors who are shareholders of a particular issuer. The motivation for such a combination is, as Kitain suggest, that there is a need for information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36)

With regard to Claim 18, Magary teaches the method comprising:

the Investors of the Issuer using an investor system to connect to the electronic dissemination and tabulation system to vote via the E-broker system. (Page 3, Para. 32)

Magary does not disclose the following limitations:

an Issuer of investment securities, an agent thereof or a third party, notifying an electronic dissemination and tabulation provider of an event requiring the dissemination of information or a vote of Investors of the issuer by electronic means;

and the electronic dissemination and tabulation provider capturing data from at least one E-broker system on the Investors of the Issuer;

However, Kitain teaches both these limitations at (Col. 10 lines 26-45). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as

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described in Claim 18. The motivation for such a combination is, as Kitain suggest, that there is a need for information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36) This is particularly true as it relates to shareholder voting.

With regard to Claim 19, Magary teaches the method wherein:

the Investors securely connect to the electronic dissemination and tabulation system from a website of the E-broker system. (Page 3, Para. 32)

With regard to Claim 20, Magary does not expressly teach the method wherein:

records of an Investor's vote or an Investor's accesses to information are electronically forwarded to the Issuer.

However, Kitain teaches this limitation at (Col. 10 lines 26-45). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 20. The motivation for such a combination is, as Kitain suggest, that there is a need for information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36) This is particularly true as it relates to shareholder voting.

With regard to Claim 21, Magary does not expressly teach the method wherein:

the information includes EDGAR filings of the Issuer obtained by the electronic dissemination and tabulation system from the SEC database.

However, Kitain teaches this limitation at (Col. 4 lines 19-30). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 21. The motivation for such a combination is, as Kitain suggest, that

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there is a need for information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36). This is particularly true as it relates to EDGAR filings.

With regard to Claim 22, Magary teaches the method wherein:

the electronic dissemination and tabulation system is used to e-mail the investor system to inform the Investor of the event. (Page 4, Para. 44)

With regard to Claim 23, Magary teaches the following limitation:

Investors of the Issuer using the E-broker system to mail notice of the event;

the Investors using a website of the E-broker system to tender/exchange their securities in the Issuer. (Page 4, Para. 46)

Kitain teaches the following limitation:

an Issuer of investment securities, or an agent thereof, notifying an electronic dissemination and tabulation provider of an event; (Col. 10, lines 5-15)

the electronic dissemination and tabulation provider capturing data from an E-broker system on Investors of the issuer; (Col. 10 lines 26-45).

Neither Kitain nor Magary teaches of a method wherein:

the Investors using a website of the E-broker system to tender/exchange their securities in the Issuer.

However in an analogous case, Lerner teaches this limitation at (Page 3, Para. 43) wherein information about tender offers are distributed, and presumably received. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary, Kitain, and Lerner to disclose applicant's invention as described in Claim 23. The motivation for such a combination is, as Kitain suggest, that there is a need for an information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36).

With regard to Claim 24, Magary teaches the method wherein:

each Investor uses an investor system to connect to the electronic dissemination and tabulation system from the website. (Page 3, Para. 32)

With regard to Claim 25, Magary does not teach the method wherein:

responses of the Investors to the tender/exchange event are electronically forwarded to the E-broker system.

However, forwarding of responses from events is implied in Kitain at (Col. 10 lines 26-45), and when combined with the tender offer events of Lerner, serves to teach the limitation of Claim 25. Thus, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary, Kitain, and Lerner. The motivation for such a combination is, as Kitain suggest, that there is a need for an information delivery system that meets the needs of both corporations and of investors. (Col. 4 lines 31-36).

With regard to Claim 26, Magary teaches the method wherein:

the tender/exchange offer includes information from the SEC database obtained by the electronic dissemination and tabulation system. (Page 2, Para. 27)

With regard to Claim 27, Magary teaches the method wherein:

the electronic dissemination and tabulation system e-mails the investor system regarding the event. (Page 4, Para. 44)

With regard to Claim 28, Magary teaches the method wherein:

the Investors using investor systems to connect to an electronic dissemination and tabulation provider via a website of the at least one E-broker system to receive event information. (Col. 13 lines 43-48)

Magary does not teach the following limitation:

an Issuer of investment securities, or an agent thereof, notifying an electronic dissemination and tabulation provider of event information for Investors who trade on-line with at least one E-broker system;

However, Kitain does teach this step at (Col. 10, lines 5-15). Kitain generally teaches of a system and method for electronically delivering information and other SEC related documents by an issuer to its shareholders. Magary teaches of distributing such documents through broker web sites. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 28. The motivation for such a combination is, as Kitain suggest at (Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors.

With regard to Claim 29, Magary teaches the method wherein:

the Investors using investor systems securely connect to the electronic dissemination and tabulation provider from a website of the E-broker system.
(Page 3, Para. 32)

With regard to Claim 30, Magary does not teach the method wherein:

confirmation of an investor system accessing event information is electronically forwarded to the issuer.

However, Kitain teaches this limitation at (Col. 5 lines 53-62). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 30. The motivation for such a combination is, as Kitain suggest at

(Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors.

With regard to Claim 31, Magary teaches the method wherein:

the electronic dissemination and tabulation provider e-mails the investor system regarding the event. (Page 4, Para. 44)

With regard to Claim 32, Magary teaches the method wherein:

the Investors using an investor system to connect to an electronic dissemination and tabulation system via a website of at least one E-broker system;
(Page 3, Para. 32)

Magary does not specifically teach the step wherein:

the electronic dissemination and tabulation system remotely administers online delivery of materials to the Investors which have been authenticated into the E-broker's website,

However, Kitain does teach this step at (Col. 7 line 53 – Col. 8 line 4). Kitain generally teaches of a system and method for electronically delivering information and other SEC related documents by an issuer to its shareholders. Magary teaches of distributing such documents through broker web sites. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 32, relating to electronic dissemination. The motivation for such a combination is, as Kitain suggest at (Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors. Continuing though, Magary teaches the method further comprising:

processes related instructions related to the materials, without the Investors leaving the E-broker's website. (Page 4, Col. 52)

With regard to Claim 33, Magary does not teach the method wherein:

confirmation of an investor system accessing event information is electronically forwarded to the issuer.

However, Kitain teaches this limitation at (Col. 5 lines 53-62). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Magary and Kitain to disclose applicant's invention as described in Claim 33. The motivation for such a combination is, as Kitain suggest at (Col. 4 lines 31-36), that there is a need for information delivery system that meets the needs of both corporations and of investors.

With regard to Claim 34, Magary teaches the method wherein:

wherein the electronic dissemination and tabulation system e-mails the investor system regarding the event. (Page 4, Para. 44)

Conclusion


The following prior art, made of record but not relied upon, is considered pertinent to applicant's disclosure:

- a) Tozzoli et al., U.S. Patent #5717989, February 10, 1998, Full Service Trade System.
- b) Yurino et al., U.S. Patent #6810386, October 26, 2004, Company Information Disclosure System and Memory Medium
- c) Muftic, U.S. Patent #5850442, December 15, 1998, Secure World Wide Electronic Commerce Over an Open Network.
- d) Sanborn, U.S. Patent Application Publication #20030028467, February 6, 2003, Method of Raising Capital for Early Stage Companies through Broker-Dealer.
- e) LaFore et al., U.S. Patent Application Publication #20020032640, March 14, 2002, Data Processing System and Method for Managing Broker Transaction Information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (703) 305-4001. The examiner can normally be reached on M-F 9:00-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Alpert
March 21, 2005


ALAIN L. BASHORE
PRIMARY EXAMINER